REMARKS

Claims 1-24 were pending in this Application as of the Office action of June 17, 2008, with claim 9 having been previously cancelled. Claim 25 has been added with this Response, and claims 10 and 13 have been cancelled. Claims 1 and 18 are amended.

Rejections under 35 U.S.C. 112, second paragraph

The Examiner variously rejects claims 1-22 for being indefinite under 35 U.S.C. 112, second paragraph. Referring to the Examiner's issue with the "partial image areas," Applicant respectfully refers the Examiner to line 3 of claim 1 for antecedent basis. With respect to the Examiner's issue with "transformation with at least one search beam running, Applicant respectfully refers the Examiner to the last paragraph on page 10 of the English translation of the Application, this paragraph beginning by reciting "a second advantageous information transformation method…"

Rejections under 35 U.S.C. 102(b)

Claims 1-8, 10-13, 18-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,924,989 to Polz (Polz hereinafter). Applicant respectfully traverses.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant's amended claims 1 and 18 recite *inter alia*,

"wherein the second space elements are determined in a first step by the multidimensional image information of that first space element which forms the starting point of the search beam, and the second space elements are weighted in further steps by multidimensional image information of further first space elements which form starting points of search beams which also penetrate the second space elements, wherein the

weights orientate themselves at multidimensional distances of each second space element to the respective starting points."

Polz does not teach second space elements that are determined in a first step by the multidimensional image information of that first space element, which forms the starting point of the search beam, wherein the second space elements are weighted in further steps by multidimensional image information of further first space elements which form starting points of search beams which also penetrate the second space elements, wherein *the weights orientate themselves at multidimensional distances of each second space element to the respective starting points*. Instead, referring to column 7 lines 3-45 and Figure 7, Polz teaches weighting according to distances to pre-assigned value C, not the starting points of the search beams X1-X4, as would be required by Applicant's amended claims 1 and 18.

For at least all of the above reasons, Polz does not teach every element of Applicant's claims 1and 18, or claims 2-7, 10-12, 19-21 and 23 that depend therefrom. Accordingly, Applicant respectfully submits that Polz does not anticipate Applicant's claims 1-8, 10-13, 18-21, and 23.

Rejections under 35 U.S.C. 103(a)

Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polz in view of United States Patent No. 5,787,889 to Edwards (Edwards hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 14, 16, and 17 depend from claim 1. As such, these claims include all of the limitations of claim 1. Thus, for at least the reasons discussed in the 102 remarks, Polz does not teach every element of Applicant's claims 14, 16, and 17. As Edwards does not remedy the deficiencies of Polz, any proposed combination of Polz and Edwards also does not teach every element of Applicant's claims 14, 16, and 17. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 14, 16, and 17 with respect to the proposed combination of Polz and Edwards. Since the proposed combination of Polz and Edwards fails to teach or suggest all of the limitations of claims 14, 16, and 17, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the references, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Polz in view of Edwards, in further view of United States Patent No. 5,159,931 to Pini (Pini hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 15 depends from claim 1. As such, claim 15 includes all of the limitations of claim 1. Thus, for at least the reasons discussed in the 102 remarks, Polz does not teach every element of Applicant's claim 15. As neither Edwards nor Pini remedy the deficiencies of Polz, any proposed combination of Polz, Edwards, and Pini also does not teach every element of Applicant's claim 15. Accordingly, Applicant respectfully

submits that *prima facie* obviousness does not exist regarding claim 15 with respect to the proposed combination of Polz, Edwards, and Pini. Since the proposed combination of Polz, Edwards, and Pini fails to teach or suggest all of the limitations of claim 15, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the references, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polz in view United States Patent No. 6,674,879 to Weisman (Weisman hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 22 and 24 depend from claim 1. As such, claims 22 and 24 include all of the limitations of claim 1. Thus, for at least the reasons discussed in the 102 remarks, Polz does not teach every element of Applicant's claims 22 and 24. As Weisman does not remedy the deficiencies of Polz, any proposed combination of Polz and Weisman also does not teach every element of Applicant's claims 22 and 24. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 22 and 24 with respect to the proposed combination of Polz and Weisman. Since the proposed combination of Polz and Weisman fails to teach or suggest all of the limitations of claims 22and 24, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the references, or a reasonable likelihood of

success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Applicant respectfully notes that Applicant's original claims 6-11 were found to include novel and inventive subject matter with regards to Polz in the International Preliminary Examination Report issued by the International Bureau on November 4, 2004.

Conclusion

Applicant respectfully submits that the prior art rejections are herein overcome. Applicant respectfully requests withdrawal of all rejections and objections and issuance of a Notice of Allowance.

Applicant hereby petitions under 37 C.F.R. §§1.136, 1.137 for any extension of time necessary for entry and consideration of the present Response.

If there are any charges with respect to this amendment, or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

The Examiner is invited to contact Applicant's attorneys at the below telephone number regarding this Response or otherwise concerning the present application.

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